

As a preliminary matter, applicants wish to point out to the Examiner that claims 1-6 have been previously cancelled and therefore are no longer pending in the present application. Claims 1-6 were cancelled in connection with the filing of this divisional patent application under 37 C.F.R. §1.53(b) on February 8, 2002. Therefore, only claims 7-23 (designated as Groups II and III) are currently pending and at issue in the present application.

## **I. Claim Group Election**

In response to the Examiner's current restriction of claim Groups II and III, applicants provisionally elect examination of Group II, claims 7-17 drawn to a method for identifying substances that modulate nuclear translocation of an armadillo protein. The Requirement is not believed to be well taken however, and is respectfully traversed. The applicants respectfully request modification of the Requirement to allow prosecution of both Groups II and III, for the reasons provided as follows.

## **II. Traversal of Restriction Requirement**

The Examiner alleges that the methods of Groups II and III require different products and steps and have different endpoints and therefore are patentably distinct. Office Action, p. 2, para. 3.

Under 35 U.S.C. §121, "two or more independent and distinct inventions... in one application may... be restricted to one of the inventions". Inventions are "independent" if there is no distinct relationship between the two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." MPEP §802.01 (emphasis in original).

However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear:

1. Separate classification;
2. Separate status in the art; or,
3. Different field of the search.

Moreover, according to Patent Office examining procedures, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP §803 (emphasis added).

Applicants respectfully submit that Groups II and III designated by the Examiner fail to define methods that warrant separate examination and search. Claims 7-23 represent a web of knowledge and continuity of effort that merits examination in a single application. In particular, the basis for traversal is that the subject matter of Group II cannot be examined without examination of the subject matter of Group III, for the reasons outlined below:

1. The subject matter of Groups II and III have been classified into the same class (435).
2. Group III utilizes the assay of Group II, therefore a thorough search of the subject matter of Group II would necessarily include a search of the subject matter of Group III as both relate to nuclear translocation of armadillo proteins.

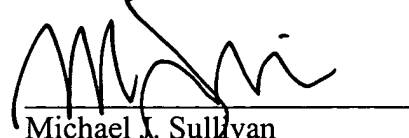
The search and examination of Group II and III is necessarily co-extensive, and in any event would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner. Accordingly, applicants respectfully request that the Examiner modify the Requirement for Restriction and examine claims 7-23 (Groups II and III) together. If the Examiner modifies the restriction requirement to combine Groups II and III, applicants' election is without traversal.

### **III. Conclusion**

Early and favorable consideration of this response and the claims is earnestly solicited. If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the

Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Sullivan', written over a horizontal line.

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